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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Terry L. McMahon

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DORSEY & WHITNEY LLP

INTELLECTUAL PROPERTY DEPARTMENT

SUITE 1500

50 SOUTH SIXTH STREET

MINNEAPOLIS, MN 55402-1498

EXAMINER

NELSON, FREDA ANN

ART UNIT

PAPER NUMBER

3628

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/820,223	Applicant(s) MCMAHON ET AL.	
	Examiner Freda A. Nelson	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-25 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-25 and 27-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment received on May 31, 2007 is acknowledged and entered. Claims 23-25 have been amended. Claims 1-22 and 26 have been canceled. Claims 27-31 have been added. Claims 23-25 and 27-31 are currently pending.

Response to Amendments and Arguments

Applicant's arguments filed May 31, 2007 have been fully considered but they are not persuasive.

In response to applicant's arguments, the recitation "building a custom specification and a quote for purchasing a piece of equipment by a potential customer from a salesperson in a transaction therebetween" as recited in claim 23 has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's arguments, the recitation "building a custom specification and a quote for purchasing or leasing a piece of equipment by a potential customer from a salesperson in a transaction therebetween" as recited in claim 24 has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the

Art Unit: 3628

purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Examiner Note

Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Objections

Claims 23-24 are objected to because of the following informalities:

As per claims 23-24, line three respectively, "therebetween" should be "there between". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 23-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Henson (Patent Number 6,167,383).

As per claim 23, Henson discloses a method in a computerized system for building a custom specification and a quote for purchasing a piece of equipment by a potential customer from a salesperson in a transaction therebetween, comprising:

providing at least one pre-engineered specification to at least one of the potential customer and the salesperson wherein the pre-engineered specification is a specification for one or more designs of a component for which existing designs have been completed (col. 1, lines 23-25);

displaying the at least one pre-engineered specification for the equipment (col. 1, lines 23-25);

electronically soliciting from the at least one of the potential customer and the salesperson a user a selection of one of the at least one pre-engineered specification (col. 7, line 57 through col. 8, line 6);

electronically soliciting from the at least one of the potential customer and the salesperson a manufacturer of one component of the equipment (FIG. 3A);

displaying options and prices for the component and allowing the at least one of the potential customer and the salesperson to select at least one option for the component, wherein the displaying options and prices includes updating the displayed options and prices after an interrelated option has been selected (FIG. 3A-3B and FIGS. 4-6);

generating a report showing the options selected for the component and a subtotal cost for the component (col. 6, lines 21-34; FIGS. 3A-3B and FIGS. 4-6); and

generating a report showing the components selected and the total coast of the equipment (col. 6, lines 21-34; FIGS. 3A-3B and FIGS. 4-6).

As per claim 24, Henson discloses a method in a computerized system for building a custom specification and a quote for leasing a piece of equipment by a potential customer from a salesperson in a transaction therebetween, comprising:

providing at least one pre-engineered specification to at least one of the potential customer and the salesperson wherein the pre-engineered specification is a specification for one or more designs of a component for which existing designs have been completed (col. 1, lines 23-25, FIGS. 3A and 4);

displaying the at least one pre-engineered specification for the equipment (col. 1, lines 23-25);

electronically soliciting from the at least one of the potential customer and the salesperson a user a selection of one of the at least one pre-engineered specification (col. 7, line 57 through col. 8, line 6);

electronically soliciting from the at least one of the potential customer and the salesperson a manufacturer of one component of the equipment (FIG. 3A);

displaying options and prices for the component and allowing the at least one of the potential customer and the salesperson to select at least one option for the component, wherein the displaying options and prices includes updating the displayed options and prices after an interrelated option has been selected (FIG. 3A-3B and FIGS. 4-6);

generating a report showing the options selected for the component and a subtotal cost for the component (col. 6, lines 21-34; FIGS. 3A-3B and FIGS. 4-6); and

generating a report showing the components selected and the total coast of the equipment (col. 6, lines 21-34; FIGS. 3A-3B and FIGS. 4-6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 25 and 27-31 are rejected under rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (Patent Number 6,167,383), in view of Hanzek (US

Art Unit: 3628

Patent Number 6,980,963), still in further view of Thompson (US Patent Number 6,810,401).

As per claims 25 and 27-28, Henson does not expressly disclose wherein the leased equipment is construction equipment, manufacturing equipment, and vehicle fleet. Information as to wherein the leased equipment is manufacturing equipment, vehicle fleet or construction equipment is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in claims 25 and 27-28 would be performed the same regardless of the type of equipment.

Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that it was old and well known to purchase or lease a variety of products because such type of equipment does not functionally relate to the steps in the method claimed and because the type of equipment leased does not patentably distinguish the claimed invention.

As per claims 29-31, Henson does not expressly disclose that the method of claim 23, wherein the equipment is a construction equipment.

However, Hanzek discloses after the on-line consumer selects the vehicle make and model, configurations and options, he/she may submit the vehicle selection and perform a search in inventory to determine if one is currently available. Inventory database 322 receives its data from an inventory importer 328, which obtains inventory data from dealers 330 for their current inventory. Dealers 330 may also represent any sales entity that has an inventory of products for sale or lease to the public or to businesses (col. 8, lines 23-31).

Thompson et al. disclose although the configuration system (and corresponding method) has been specifically described in connection with the configuration of a window/door product, it should be apparent that the system (and method) can be applied to **any product, service, or component** that is to be designed or configured such as cabinets, rooms, houses, cars, landscape designs, clothing, etc (col. 18, lines 24-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Henson et al. to include the feature of Hanzek and Thompson et al. in order to provide the users with the ability to configure and get quotes for vehicles and various other products.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

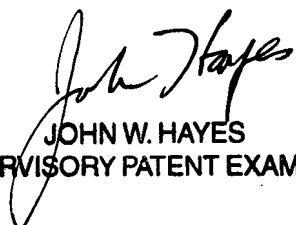
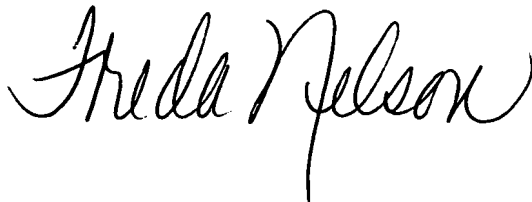
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3628

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FAN 07/30/2007



JOHN W. HAYES
SUPERVISORY PATENT EXAMINER